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PATENT

Attorney Docket No.: 018781-006810US

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TOWNSEND and TOWNSEND and CREW LLP

By: _____

Dana Kane

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

POWERS et al.

Application No.: 10/041,030

Filed: December 28, 2001

For: DIAGNOSIS AND TREATMENT
OF CANCER USING MAMMALIAN
PELLINO POLYPEPTIDES AND
POLYNUCLEOTIDES

Customer No.: 20350

Confirmation No. 2471

Examiner: Susan Ungar

Group Art Unit: 1642

**RESPONSE TO RESTRICTION
REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed September 20, 2004, Applicants elect Group 16, claims 8-13, drawn to a method of detecting lung cancer cells comprising detecting a gene encoding SEQ ID NO:4, or a variant. Enclosed herewith is a fee authorization to extend the time for response for one month.

This election is made with traverse. According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, the MPEP at § 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. Applicants respectfully submit that a

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Amdt. dated October 21, 2004
Reply to Office Action of September 20, 2004

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proper search of the claims drawn to detection of cancer by detecting nucleic acid and amino acid sequences relating to SEQ ID NO:4 would not constitute an undue burden, as a proper search would likely encompass both nucleic acid and protein sequences. Applicants therefore request rejoinder of Groups 7-12 and Groups 16-18.

Further, the restriction of the generic claim relating to detecting cancer by detecting a gene relating to SEQ ID NO:4 into separate groups by designating 8 and 11 as linking claims appears to preclude Applicants from being able to obtain claims to more than one species (should the generic claim not be allowable) in the same application, even when those species are determined to be free of the prior art during the examination of the generic claim. This practice is a departure from the practice in the chemical art units, which typically allow claims to issue with multiple species when a generic claim is not found to be allowable. Moreover, the Examiner's restriction is contrary to MPEP § 803.02, which relates to restriction practice and Markush-type claims (e.g., claim 12). There, the MPEP directs that for Markush-type claims, where the members of the Markush groups are sufficiently few in number and examination of the claims can be made without serious burden, the examiner must examine all member together. Even if the Examiner deems that it would require undue burden, then the proper practice is to issues a species election requirement, not a restriction (*see*, procedure detailed in MPEP § 803.02). Thus, at a minimum, Applicants respectfully request rejoinder of Groups 16-18.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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